# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/660,160 | 09/11/2003 | Daniel Joseph Heithoff | ROC920030088US1 | 7388 |

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
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| 3688 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/660,160 | HEITHOFF ET AL. |
| | **Examiner** | **Art Unit** | |
| | MICHAEL STIBLEY | 3688 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *7/6/2009*.
2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-5 and 22-25* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-5 and 22-25* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some *  c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____ .
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)                    Office Action Summary                    Part of Paper No./Mail Date 20090911

## DETAILED ACTION

### Request for Continued Examination

1.      Receipt is acknowledged of a request for continued examination, filed on 7/6/2009, under

37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 6/8/2009.

Prosecution is herby re-opened, a detailed action follows:

### Response to Arguments

**2.      Applicant contends that Claims 1-5 and 22-25 are claim statutory subject matter**

**and contends that "sending the associated recommended offering and an identification of a**

**marketing channel computer to the client electronic device and sending a notification to the**

**marketing channel computer" transforms the client electronic device and the marketing**

**channel computer into a different state.**

Examiner disagrees and maintains the §101 rejection of claims 1-5 and 22-25.  The claims are

directed to a process and involves a method or a series of acts or steps.  While the claim requires

the method to be implemented by a particular machine, the use of the particular machine does

not impose a meaningful limit on the claim's scope as the use of the machine does not involve

more than a field of use limitation and does not involve more than insignificant extra-solution

activity.  Examiner considers the use of the machine to be receiving data from a client electronic

device.  Receiving data is considered to be data gathering or data transmission and Examiner

considers this to be insignificant extra solution activity.  Additionally, the claim does not require

that the method particularly transform a particular article.  While Applicant argues sending the

associated recommended offering and an identification of a marketing channel computer to the

client electronic device and sending a notification to the marketing channel computer is

transformation to a different state, Examiner considers this to not meet the requirement of

transforming a particular article as this is mere data transmission and the computer remains of

the same nature and character during the transmission of the recommendation and the method is

drawn to a method of making a recommendation.

Applicant's remaining arguments are addressed with the new basis of rejection below.

## CLAIM STATUS

3.      Claims 1-5 and 22-25 are currently pending in the instant application and have been

examined.

### Claim Rejections - 35 USC § 112

4.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.      Claims 1-5 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As to Claim 1 and its dependent claims, the claim language "a determination whether the

trend at the client electronic device is increasing during the estimated time period" is unclear as

the estimated time period is a future time period and the trend would be expected to increase as

opposed to "is increasing". Appropriate action is required.

## *Claim Rejections - 35 USC § 101*

6.      35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.      **Claims 1-5 and 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**As per Claims 1-5 and 22-25:**  The claims are directed to a process and involves a method or a series of acts or steps.  While the claim requires the method to be implemented by a particular machine, the use of the particular machine does not impose a meaningful limit on the claim's scope as the use of the machine does not involve more than a field of use limitation and does not involve more than insignificant extra-solution activity.  Examiner considers the use of the machine to be receiving data from a client electronic device.  Receiving data is considered to be data gathering or data transmission and Examiner considers this to be insignificant extra solution activity.  Additionally, the claim does not require that the method particularly transform a particular article.  While Applicant argues sending the associated recommended offering and an identification of a marketing channel computer to the client electronic device and sending a notification to the marketing channel computer is transformation to a different state, Examiner considers this to not meet the requirement of transforming a particular article as this is mere data transmission and the computer remains of the same nature and character during the transmission of the recommendation and the method is drawn to a method of making a recommendation.

## Double Patenting

8.      The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9.      **Claims 1-5 and 22-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of United States Patent 7,055,149**

B2.  Although the conflicting claims are not identical, they are not patentably distinct from each other.

| Comparison of Claims Table | |
|---|---|
| Claim 1 Instant Application 10/660,160 filed by International Business Machines (assignee/owner) | Claim 2 of United States Patent 7,055,149 filed by International Business Machines (assignee/owner) subsequently assigned to Lenovo (Singapore) PTE LTD. (conflicting claims) |
| A computer implemented method comprising: **receiving** data from a client electronic device upon an occurrence of an event, wherein the data comprises an **inventory of components** installed at the client electronic device, and wherein the data further comprises a plurality | A method for upgrading a software on a customer system, comprising: **receiving**, by a supplier system, a **software inventory** from the customer system; verifying one or more business contracts for the **software inventory** utilizing one or more databases connected to |

| | |
|---|---|
| of fields, and wherein the event is selected from a group consisting of installation of hardware at the client electronic device, **installation of software at the client electronic device,** detection of a performance problem at the client electronic device, and detection of an error at the client electronic device; comparing a subset of the plurality of fields to a plurality of thresholds via a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the plurality of thresholds to values in subset of the plurality of fields, and specify an associated recommended offering, wherein the subset of the plurality of fields of the data comprises a trend at the client electronic device, wherein the trend comprises **a rate of growth of consumption of a resource** at the client electronic device and an estimated time period until the resource is constrained, and wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device is increasing during the estimated time period; and when the plurality of conditions are met by the comparing of the values in the subset of the plurality of fields to the plurality of thresholds, sending the associated recommended offering and an identification of a marketing channel computer to the client electronic device and sending a notification to the marketing channel computer, wherein the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the **recommended offering** was made comprises a subset of the data that explains a reason for a need for the recommended offering, and wherein the client electronic device displays the associated recommended offering via an output device. | the supplier system; determining one or more **software upgrade releases** for the software inventory utilizing a product topology database connected to the supplier system; **receiving an order for additional software**; and verifying pre-requisite and co-requisite software for the additional software. |

While Claim 2 of US Patent 7,055149 teaches taking a software inventory of a computing device of a customer where an order for additonal software is obtained after determining one or more software upgrade releases.

Claim 1 of the instant application also discloses software inventory of a computing device where recommendation is made for a customer as to installation of software with a plurality of fields and thresholds to be met (pre-requisite and co-requisite software).

It would have been obvious to a person having ordinary skill in the art to have combined the recommending an offering of the instant application to the claims of US Patent 7,055,149 B2 Official Notice is taken that it is well known to receive orders once recommendations are made. One would have been motivated to make recommendations in order to encourage receiving orders for additional software in order to encourage users to receive software upgrade releases.

### *Claim Rejections - 35 USC § 102*

10.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11.      **Claims 1-5 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Ken Hayward et al (HAYWARD)(United States Patent 6,798,997 B1).**

**As per Claim 1**: <u>HAYWARD</u> teaches:  A computer implemented method comprising: <u>Col 4</u>

<u>lines 10-20</u>

receiving data from a client electronic device upon an occurrence of an event, wherein the data

comprises an inventory of components installed at the client electronic device, and wherein the

data further comprises a plurality of fields,

> <u>See at least Col 6 lines 1-13; "...particular condition to the user, for example on a display</u>
>
> <u>screen..." Col 5 lines 15-22  See also Figs 3 and 4  See also "...inventory..." Col 8 lines 35-</u>
>
> <u>55 See also "...fields..." Col 4 lines 45-55</u>

and wherein the event is selected from a group consisting of installation of hardware at the client

electronic device, installation of software at the client electronic device, detection of a

performance problem at the client electronic device, and detection of an error at the client

electronic device;

> <u>See at least "...error conditions..." Col 1 lines 20-37; See also Col 6 lines 1-13</u>

comparing a subset of the plurality of fields to a plurality of thresholds via a plurality of

conditions, wherein the plurality of conditions specify the subset, specify a comparison of the

plurality of thresholds to values in subset of the plurality of fields,

> <u>See at least "...consumable has reached a predetermined threshold..." Col 8 lines 25-31 See</u>
>
> <u>also "...threshold conditions..." Col 9 lines 25-33  "...upon identification of a threshold</u>
>
> <u>condition..." Col 2 lines 20-25 "...the condition may be used to indicate when a consumable</u>

has been exhausted (paper tray empty) or a consumable has reached a predetermined

threshold (eg magenta ink level low)..." Col 8 lines 25-30

and specify an associated recommended offering,

> See at least Col 9 lines 50-60 "...the marking apparatus may be programmed to
>
> communicate an offer to purchase a consumable component..." See also Col 2 lines 45-51
>
> "...the imaging apparatus automatically electronically communicates an offer to purchase a
>
> replacement part for the replaceable part upon occurrence of a defined threshold
>
> condition..."

wherein the subset of the plurality of fields of the data comprises a trend at the client electronic

device, wherein the trend comprises a rate of growth of consumption of a resource at the client

electronic device and an estimated time period until the resource is constrained,

> See at least "...supply, wear, usage, rate of depletion, rate of wear, predicted date of
>
> depletion of supply...predicted ate of need of consumable component...statistical data for
>
> consumable component..."

and wherein one of the plurality of conditions specifies a determination whether the trend at the

client electronic device is increasing during the estimated time period;

> "...rate of depletion...predicted date of depletion of supply..." Depletion represents
>
> increased wear, use of the consumable. Col 9 lines 25-33

and when the plurality of conditions are met by the comparing of the values in the subset of the

plurality of fields to the plurality of thresholds, sending the associated recommended offering

and an identification of a marketing channel computer to the client electronic device and sending

a notification to the marketing channel computer,

"…the sensor and software system automatically offers to purchase a replacement for the cartridge upon identification of a threshold condition in the cartridge…" Col 2 lines 60-65 See also Col 10 lines 30-41  See also "…the marking apparatus may electronically initiate a purchase offer, electronically receive an acceptance of the purchase offer, and electronically form a contract with a supplier for purchase of the replaceable part or consumable component…" Col 9 lines 43-45

wherein the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering,

Col 6 lines 1-13 See at least "…explained as "Magenta Ink Level Low"…"  See also "…Pressing the "Show me" button…" Col 6 lines 1-13

and wherein the client electronic device displays the associated recommended offering via an output device.

See at least "…the browser displays the screen to the user, the user selects such online purchasing options…" Col 7 lines 60-67

Examiner considers "wherein the data comprises and inventory of components installed at the client electronic device" and "wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering" to be nonfunctional descriptive material, yielding no patentable weight.

**As per Claim 2**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the associated recommended offering further comprises an offer for a service.

    <u>See at least: "...selected service..." Col 5 lines 34-40; Col 5 lines 50-55</u>

**As per Claim 3**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the data comprises a hardware inventory of the client electronic device.

    <u>See at least Col 7 lines 1-5; Col 8 lines 35-40</u>

**As per Claim 4**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the data comprises a software inventory of the client electronic device.

    <u>See at least Col 4 lines 10-15; Col 8 lines 35-40</u>

**As per Claim 5**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the data comprises a performance inventory of the client electronic device.

    <u>See at least Col 7 lines 45-50: Col 8 lines 35-40</u>

**As per Claim 22**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: further comprising: saving a history of the inventory as the inventory changes over

time.  <u>See at least Col 8 lines 35-40</u>

**As per Claim 23**: <u>HAYWARD</u> teaches:  The method of claim 22 as discussed above and further

discloses: wherein the comparing further comprises: comparing a plurality of records in the

history.  <u>See at least Col 7 lines 30-35</u>


**As per Claim 24**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the associated recommended offering comprises an offer for hardware.

    <u>See at least Col 2 lines 45-50</u>

**As per Claim 25**: <u>HAYWARD</u> teaches:  The method of claim 1 as discussed above and further

discloses: wherein the receiving further comprises: periodically receiving updates to the data

from the client electronic device.

> <u>See at least Col 7 lines 35-40; See also Col 2 lines 45-50</u>

### *Claim Rejections - 35 USC § 103*

12.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains.  Patentability shall not be negatived
> by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.     Determining the scope and contents of the prior art.
2.     Ascertaining the differences between the prior art and the claims at issue.
3.     Resolving the level of ordinary skill in the pertinent art.
4.     Considering objective evidence present in the application indicating obviousness
       or nonobviousness.

13.     **Claims 1-5 and 22-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suellen Kae Birkholz et al (<u>BIRKHOLZ</u>)(US 7,055,149 B2) in view of Peter Roy Ballantine et al (<u>BALLANTINE</u>)(US 6,446,123 B1).**

**As per Claim 1**: <u>**BIRKHOLZ**</u> teaches:  A computer implemented method comprising:

<u>See at least "…Fig 1 is a diagram of a networked environment generally defining a relationship between a computer system customer/owners side and a computer system supplier side…The computer systems may be any computerized device including personal computers (PCs), workstations, servers, wireless devices, personal digital assistants (PDAs), and the like…" Col 4 lines 50-67; see also Fig 1</u>

receiving data from a client electronic device upon an occurrence of an event, wherein the data comprises an inventory of components installed at the client electronic device, and wherein the data further comprises a plurality of fields,

<u>See at least Fig 38; See also "…receiving, by a supplier system, a **software inventory [inventory of components]** from the customer system…" Col 2 lines 15-17 See also "…the software sales representative must determine the software inventory currently installed on the customer system…" Col 1 lines 45-47 See also "…machine software inventory is sent directly from the selected hardware of the customer system as directed by the customer…" Col 28 lines 60-65 See also "…The GUI may have a variety of fields with default entries compiled from customer/product registration information…" Col 32 lines 44-50</u>

and wherein the event is selected from a group consisting of installation of hardware at the client electronic device, installation of software at the client electronic device, detection of a

performance problem at the client electronic device, and detection of an error at the client

electronic device;

> See at least "…a method for collecting information on the installed software on the
>
> customer's machine and processing the collected information in a supplier system…" Col 2
>
> lines 23-26  See also "…performance data…" Column 19 lines 19-32  See also Fig 12  See
>
> also "…the customer machine information database contains customer supplied information
>
> about specific computers.  For each particular computer, such information may include a
>
> model number, a machine type, a plant code, hardware inforamtion (for various devices
>
> resident on the computer)..." Col 19 lines 7-12 See also "...display error messages…" Col 23
>
> lines 45-50

comparing a subset of the plurality of fields to a plurality of thresholds via a plurality of

conditions, wherein the plurality of conditions specify the subset, specify a comparison of the

plurality of thresholds to values in subset of the plurality of fields,

and specify an associated recommended offering,

> See at least "…the system sizer employs a system model selection function, referred to as
>
> the comparison tool, to construct the set of all systems capable of meeting the system
>
> capacity requirements…" Col 7 lines 45-50  See also Fig 9 and Col 12 lines 17-41  See also
>
> "…recommendation table…" Col 12 lines 1-16

wherein the subset of the plurality of fields of the data comprises a trend at the client electronic

device, wherein the trend comprises a rate of growth of consumption of a resource at the client

electronic device and an estimated time period until the resource is constrained,

> See at least "…memory growth trend field…" Col 15 lines 25-30 See also "…estimated
>
> system attributes entry and a time period entry…" Col 12 lines 5-6

and when the plurality of conditions are met by the comparing of the values in the subset of the

plurality of fields to the plurality of thresholds, sending the associated recommended offering

and an identification of a marketing channel computer to the client electronic device and sending

a notification to the marketing channel computer, wherein the notification comprises a request to

receive information regarding why the recommended offering was made,

> See at least Fig 38 element 3830 "Why should I use IBM Electronic Services FRO AS/400?
>
> See at least Fig 18 and "…a system recommendation GUI. The GUI contain system
>
> recommendation information resulting from the recommend table and which will be passed
>
> to the comparison tool…" Col 15 lines 50-67

and wherein the client electronic device displays the associated recommended offering via an

output device.

> See at least Fig 38 element 3830 "Why should I use IBM Electronic Services FRO AS/400?
>
> See at least Fig 18 and "…a system recommendation GUI. The GUI contain system
>
> recommendation information resulting from the recommend table and which will be passed
>
> to the comparison tool…" Col 15 lines 50-67

Examiner considers "wherein the data comprises and inventory of components installed

at the client electronic device" and "wherein the information regarding why the recommended

offering was made comprises a subset of the data that explains a reason for a need for the

recommended offering" to be nonfunctional descriptive material, yielding no patentable weight.

**In general,** **BIRKHOLZ** teaches a system and method for automating software

upgrades

**Although** **BIRKHOLZ** teaches a system and method for automating software upgrades,

**nevertheless,** **BIRKHOLZ** does not expressly disclose and wherein one of the plurality of

conditions specifies a determination whether the trend at the client electronic device is increasing

during the estimated time period;

or wherein the information regarding why the recommended offering was made comprises a

subset of the data that explains a reason for a need for the recommended offering,

**HOWEVER,** **BALLANTINE** does teach and wherein one of the plurality of conditions

specifies a determination whether the trend at the client electronic device is increasing during the

estimated time period; or wherein the information regarding why the recommended offering was

made comprises a subset of the data that explains a reason for a need for the recommended

offering,

(See at least **BALLANTINE** "…details reasons impact and recommended actions time

to threshold estimated time to fix…" Fig 3 elements 330, 310 and 340 See also Col 6 lines 28-

35; Col 6 lines 40-47 )

**THEREFORE,** it would have been obvious to a person having ordinary skill in the art at

the time of the invention to have combined the teachings of **BALLANTINE** with **BIRKHOLZ**

so as to provide a system and method to provide recommendations based on increasing

constraints on system components **thereby** allowing for users to repair computer components

before approaching failure or capacity in order to prevent discontintinuance or interruption of a

user's use of computer.

**As per Claim 2**: **<u>BIRKHOLZ</u>** and **<u>BALLANTINE</u>** teach: The method of claim 1 as discussed above **<u>BIRKHOLZ</u>** further discloses: wherein the associated recommended offering further comprises an offer for a service.

<u>See at least Col 24 lines 55-60</u>

**As per Claim 3**: **<u>BIRKHOLZ</u>** and **<u>BALLANTINE</u>** teach: The method of claim 1 as discussed above **<u>BIRKHOLZ</u>** further discloses: wherein the data comprises a hardware inventory of the client electronic device.

<u>See at least "…a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system…" Col 2 lines 23-26  See also "…performance data…" Column 19 lines 19-32  See also Fig 12  See also "…the customer machine information database contains customer supplied information about specific computers.  For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages…" Col 23 lines 45-50</u>

**As per Claim 4**: **<u>BIRKHOLZ</u>** and **<u>BALLANTINE</u>** teach: The method of claim 1 as discussed above **<u>BIRKHOLZ</u>** further discloses: wherein the data comprises a software inventory of the client electronic device.

See at least "…a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system…" Col 2 lines 23-26  See also "…performance data…" Column 19 lines 19-32  See also Fig 12  See also "…the customer machine information database contains customer supplied information about specific computers.  For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages…" Col 23 lines 45-50

**As per Claim 5**: **BIRKHOLZ** and **BALLANTINE** teach:  The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the data comprises a performance inventory of the client electronic device.

See at least "…a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system…" Col 2 lines 23-26  See also "…performance data…" Column 19 lines 19-32  See also Fig 12  See also "…the customer machine information database contains customer supplied information about specific computers.  For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages…" Col 23 lines 45-50

**As per Claim 22**: **BIRKHOLZ** and **BALLANTINE** teach:  The method of claim 1 as discussed above **BIRKHOLZ** further discloses: further comprising: saving a history of the inventory as the inventory changes over time.

See at least "…at some time interval (monthly) the historical summary server operates to

merge the summarized agent data with older history data (previously collected from the

same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

**As per Claim 23**: **BIRKHOLZ** and **BALLANTINE** teach: The method of claim 22 as

discussed above **BIRKHOLZ** further discloses: wherein the comparing further comprises:

comparing a plurality of records in the history.

See at least "…at some time interval (monthly) the historical summary server operates to

merge the summarized agent data with older history data (previously collected from the

same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

**As per Claim 24**: **BIRKHOLZ** and **BALLANTINE** teach: The method of claim 1 as discussed

above **BIRKHOLZ** further discloses: wherein the associated recommended offering comprises

an offer for hardware.

See at least Col 17 lines 1-7

**As per Claim 25**: **BIRKHOLZ** and **BALLANTINE** teach: The method of claim 1 as discussed

above **BIRKHOLZ** further discloses: wherein the receiving further comprises: periodically

receiving updates to the data from the client electronic device.

See at least Col 7 lines 1-16

## *Conclusion*

14.    The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harrop  (US 7,203,746 B1) provides for "System and Method for Adaptive Resource management".

Mikami et al (5,704,031) provides for "Method of Performing Self-Diagnosing Hardware, Software and firmware at a client node in a client/server system."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL STIBLEY whose telephone number is (571) 270-3612.  The examiner can normally be reached on Mon. - Fri. 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT WEINHARDT can be reached on (571) 272-6633.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/M. S./                                                    /ROBERT  WEINHARDT/

Examiner, Art Unit 3688

Supervisory Patent Examiner, Art Unit 3688